

ESTTA Tracking number: **ESTTA333783**Filing date: **02/23/2010**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	McDonald's Corporation
Granted to Date of previous extension	02/24/2010
Address	One McDonald's Plaza Oak Brook, IL 60523-1900 UNITED STATES

Attorney information	John A Cullis Neal, Gerber & Eisenberg LLP 2 North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, jcullis@ngelaw.com, llozada@ngelaw.com, rbrowne@ngelaw.com Phone:312.269.8000
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**Applicant Information**

Application No	77756795	Publication date	10/27/2009
Opposition Filing Date	02/23/2010	Opposition Period Ends	02/24/2010
Applicant	Yablonowski, Tim 13487 Rosewood Lane Naples, FL 34119 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 020. All goods and services in the class are opposed, namely: Plastic lids
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	743572	Application Date	05/04/1961
Registration Date	01/08/1963	Foreign Priority Date	NONE
Word Mark	MCDONALD'S		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class U100 (International Class 042). First use: First Use: 1948/12/00 First Use In Commerce: 1953/05/06 Drive-In Restaurant Services

U.S. Registration No.	939100	Application Date	07/22/1971
Registration Date	07/25/1972	Foreign Priority Date	NONE
Word Mark	MCDONALDLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1971/01/01 First Use In Commerce: 1971/01/01 RESTAURANT SERVICES		

U.S. Registration No.	1266500	Application Date	06/21/1982
Registration Date	02/07/1984	Foreign Priority Date	NONE
Word Mark	MC DOUBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1977/06/30 First Use In Commerce: 1977/09/30 a Sandwich for Consumption On or Off Premises		


U.S. Registration No.	1315979	Application Date	06/11/1982
Registration Date	01/22/1985	Foreign Priority Date	NONE
Word Mark	MCRIB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1981/06/30 First Use In Commerce: 1981/06/30 a Sandwich for Consumption On or Off the Premises		

U.S. Registration No.	1485633	Application Date	02/13/1984
Registration Date	04/19/1988	Foreign Priority Date	NONE
Word Mark	MCMUFFIN		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 RESTAURANT SERVICES

U.S. Registration No.	1450104	Application Date	09/30/1982
Registration Date	07/28/1987	Foreign Priority Date	NONE
Word Mark	MCNUGGETS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/04/00 First Use In Commerce: 1980/04/00 RESTAURANT SERVICES		

U.S. Registration No.	1577119	Application Date	06/22/1989
Registration Date	01/09/1990	Foreign Priority Date	NONE
Word Mark	MCFAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1988/12/03 First Use In Commerce: 1989/02/01 RESTAURANT SERVICES		

U.S. Registration No.	1579598	Application Date	06/02/1989
Registration Date	01/23/1990	Foreign Priority Date	NONE
Word Mark	MCCLIP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1985/10/02 First Use In Commerce: 1985/10/02 BARBER SHOP SERVICES		

U.S. Registration No.	1592450	Application Date	08/21/1989
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Registration Date	04/17/1990	Foreign Priority Date	NONE
Word Mark	MCPOOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1989/07/06 First Use In Commerce: 1989/07/06 RECREATIONAL SERVICES IN THE NATURE OF PROVIDING SWIMMING FACILITIES		

U.S. Registration No.	1735904	Application Date	07/23/1991
Registration Date	12/01/1992	Foreign Priority Date	NONE
Word Mark	MCFREE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1983/00/00 First Use In Commerce: 1985/00/00 chemical preparations to prevent and cure clogged drains		


U.S. Registration No.	1947099	Application Date	08/08/1991
Registration Date	01/09/1996	Foreign Priority Date	NONE
Word Mark	MC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1995/06/14 First Use In Commerce: 1995/06/14 restaurant services		

U.S. Registration No.	2056279	Application Date	09/28/1995
Registration Date	04/22/1997	Foreign Priority Date	NONE
Word Mark	MCDIRECT SHARES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1995/11/06 First Use In Commerce: 1995/11/06 financial services, namely providing a direct company stock purchase plan		

U.S. Registration No.	2678444	Application Date	12/11/1998
Registration Date	01/21/2003	Foreign Priority Date	NONE
Word Mark	MCSCHOLAR		
Design Mark			


Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1997/01/31 First Use In Commerce: 1997/01/31 Educational services namely providing educational scholarships

U.S. Registration No.	2684782	Application Date	09/12/2001
Registration Date	02/04/2003	Foreign Priority Date	NONE
Word Mark	MCTEACHER'S NIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2001/11/15 First Use In Commerce: 2001/11/15 CHARITABLE FUNDRAISING		

U.S. Registration No.	3151707	Application Date	05/12/2004
Registration Date	10/03/2006	Foreign Priority Date	NONE
Word Mark	MCGRIDDLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 HOT CAKES		

U.S. Registration No.	3407069	Application Date	03/16/2006
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	MCSKILLET		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 2006/04/13 First Use In Commerce: 2006/04/13 BREAKFAST ENTREES CONSISTING OF EGGS, MEAT, CHEESE AND VEGETABLES

U.S. Registration No.	3696916	Application Date	10/14/2008
Registration Date	10/13/2009	Foreign Priority Date	NONE
Word Mark	MCWORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2008/07/03 First Use In Commerce: 2008/07/03 ENTERTAINMENT SERVICES, NAMELY, PROVIDING A WEBSITE FOR INTERACTIVE ONLINE GAMES FOR CHILDREN		

Attachments	72398083#TMSN.gif ( 1 page )( bytes ) 73804079#TMSN.gif ( 1 page )( bytes ) 78417184#TMSN.jpeg ( 1 page )( bytes ) 78839012#TMSN.jpeg ( 1 page )( bytes ) 77592451#TMSN.jpeg ( 1 page )( bytes ) Notice_of_Opposition_McSippy.pdf ( 7 pages )(23065 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A Cullis/
Name	John A Cullis
Date	02/23/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:  
Application Serial No. 77/756,795  
Published in the *Official Gazette*  
Jul. 21, 2009

McDONALD’S CORPORATION,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
TIM YABLONOWSKI,	)	
	)	
	)	Mark: McSIPPY
Applicant.	)	

**NOTICE OF OPPOSITION**

Opposer, McDONALD’S CORPORATION (“McDonald’s”), a corporation organized and existing under the laws of the State of Delaware, with offices at One McDonald’s Plaza, Oak Brook, Illinois 60523-1900, believes that it will be damaged by registration of the mark “McSIPPY” in International Class 20, as shown in Application Serial No. 77/756,795 filed by Applicant, Tim Yablonowski (“Applicant”), and hereby opposes the same and requests that registration to Applicant be refused.

As grounds for its opposition, McDonald’s alleges that:

1. Applicant seeks to register a mark that consists of the term “McSIPPY” for use in International Class 20 in connection with plastic lids (hereinafter, “the McSIPPY Mark”). The application is an intent-to-use based application filed under 15 U.S.C. § 1051(1)(b).
2. McDonald’s has obtained the necessary extensions of time in which to file this Notice of Opposition. Accordingly, this Notice of Opposition is being timely submitted.



3. Since 1955, McDonald's has been in the business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a wide variety of high quality, quickly-prepared, modestly-priced foods. McDonald's has carried on this business throughout the United States and the world. McDonald's and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 14,000 restaurants in the United States.

4. In connection with this business, McDonald's has, for decades, extensively used its "Mc" family of marks, which includes the "Mc" formative used with various generic or descriptive terms, as trademarks and service marks in advertising, promoting and selling various food products and restaurant services. McDonald's even maintains a registration for the "Mc" mark alone. Over the past forty years, McDonald's has expanded its use of "Mc" formative marks across a wide variety of non-restaurant related goods and services. The following is a partial list of federal trademark registrations for "Mc" formative marks that McDonald's maintains:

	<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1.	McDONALD'S	743,572	01/08/1963	Restaurant services
2.	McDONALDLAND	939,100	07/25/1972	Restaurant services
3.	McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
4.	McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises
5.	McMUFFIN	1,485,633	04/19/1988	Restaurant Services
6.	McNUGGETS	1,450,104	07/28/1987	Restaurant Services
7.	McFAX	1,577,119	01/09/1990	Restaurant Services
8.	McCLIP	1,579,598	01/23/1990	Barbershop services

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
9. McPOOL	1,592,450	4/17/1990	Recreational services in the nature of providing swimming facilities
10. McFREE	1,735,904	12/01/1992	Chemical preparations to prevent and cure clogged drains
11. Mc	1,947,099	01/09/1996	Restaurant services
12. McDIRECT SHARES	2,056,279	09/28/1995	Financial services, namely providing a direct company stock purchase plan
13. McSCHOLAR	2,678,444	01/21/2003	Educational services, namely providing educational scholarships
14. McTEACHER'S NIGHT	2,684,782	02/04/2003	Charitable fundraising
15. McGRIDDLES	3,151,707	10/03/2006	Hot cakes
16. McSKILLET	3,407,069	04/01/2008	Breakfast entrees consisting of eggs, meat, cheese and vegetables
17. McWORLD	3,696,916	10/13/2009	Entertainment services, namely providing a website for interactive online games for children.

5. Each of the above registrations is at least *prima facie* evidence of the validity of each registration, of McDonald's ownership thereof, and of McDonald's exclusive right to use each registered mark on the goods or services set forth in its respective registration. These marks are all active, and, with the exception of McWORLD, were both in use and registered before Applicant filed his application for the McSIPPY Mark.

6. In addition to the above cited marks, McDonald's has historically used numerous "Mc" formative marks in commerce in connection with a variety of non-food related services. Such marks include: McBUDDY (charitable services), McBUTTON (novelty buttons), McCALENDAR (calendars), McDATA (consulting services), McLIGHT (flashlights),

McLODGE (hotel services), McPEN (pens), McPRODUCT (novelty items), McRULER (rulers), McSHADES (sunglasses), McSHIRT (men's and women's clothing), McSHUTTLE (transportation services), McSTORE (retail services), McTRAVEL (travel agency services) and McWATCH (watches). Such historical use is further evidence of the scope and breadth of McDonald's "Mc" family of marks.

7. Through Opposer's long, extensive and continuous use of the mark McDONALD'S and its "Mc" formative marks, the public has come to recognize marks combining the "Mc" prefix with a generic or descriptive word, when applied to a wide variety of goods and services, as a family of "Mc" marks uniquely associated with Opposer. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to the specific marks listed above, as well as for its entire "Mc" family of marks.

8. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized the validity of McDonald's Corporation's rights to its famous "Mc" and "Mac" family of marks. McDonald's Corp. v. McClain, 37 U.S.P.Q. 2d 1274, 1276 (TTAB 1995) (stating "The family of [McDonald's] marks has been recognized by this Board and by the courts"); McDonald's Corp. v. McKinley, 13 U.S.P.Q. 2d 1895, 1899 (TTAB 1989) (stating "In view of opposer's extensive evidence of use and promotion of marks having a 'Mc' or 'Mac' portion, there can be no doubt that opposer has established that its marks comprise a family"); McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1272 (S.D.N.Y. 1986) (showing no hesitation in finding that McDonald's "owns a 'family of marks' both registered and unregistered, whose common characteristic is the use of 'Mc' or 'Mac' as a formative"); J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1463 (Fed. Cir. 1991)(recognizing "McDonald's specific family of marks wherein the prefix 'Mc' is used with generic food names to create fanciful words.")

9. The term “sippy” is a generic or descriptive term when used alone in connection with plastic lids.

10. Despite McDonald’s long-standing prior rights in its “Mc” family of marks, Applicant filed its trademark application on or about June 10, 2009, to register the McSIPPY Mark as a word only mark.

11. Applicant’s advertising and intended use of the McSIPPY Mark will inevitably reach the same consumers that McDonald’s targets with its use of its famous “Mc” family of marks.

12. Consumers, upon seeing the McSIPPY Mark used in connection with Applicant’s products, are likely to mistakenly believe that such a term and the products provided in connection with it originated with or are connected with, sponsored by, associated with, or licensed or approved by McDonald’s. Thus, the registration and use by Applicant of the McSIPPY Mark in connection with the recited products is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

13. Issuance of a registration to Applicant for the McSIPPY Mark would also diminish the distinctive quality of McDonald’s rights in its famous “Mc” family of marks and would blur and otherwise impair the distinctiveness of this family of marks, in violation of 15 U.S.C. § 1125(c). In addition, should the quality of Applicant’s products be lacking, Applicant’s use of the McSIPPY Mark may also tarnish the good image of McDonald’s famous “Mc” family of marks, and would thereby cause harm to McDonald’s reputation in violation of 15 U.S.C. § 1125(c).

14. If a registration is issued to Applicant for the McSIPPY Mark, the confusion with McDonald’s marks would result in damage and injury to McDonald’s and the public. Registration of this term would give Applicant an unqualified right to wrongfully appropriate

McDonald's valuable goodwill and reputation associated with McDonald's marks; to benefit from the likely confusion among purchasers led to believe that Applicant's products are related in some fashion to McDonald's; to dilute the distinctiveness of McDonald's marks and harm its goodwill and reputation associated with its marks; to tarnish McDonald's good name by offering confusingly products not subject to McDonald's quality controls; and to restrict the natural growth of McDonald's "Mc" family of marks.

WHEREFORE, McDonald's requests that this Opposition be sustained and Application Serial No. 77/756,795 be refused registration.

Please charge the fee of \$300 and any additional fees related to this matter to Deposit Account No. 502261.

Respectfully submitted,  
McDONALD'S CORPORATION

Date: February 23, 2010

By:           /John A. Cullis /            
Robert E. Browne  
Michael G. Kelber  
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### **CERTIFICATE OF TRANSMISSION**

I hereby certify that the foregoing *Notice of Opposition* is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: February 23, 2010

By: / Luis M. Lozada /  
One of the Attorneys for McDonald’s Corporation

Robert E. Browne  
Michael G. Kelber  
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### **CERTIFICATE OF SERVICE**

I, John A. Cullis, state that I served a copy of the foregoing *Notice of Opposition*, via first class U.S. mail, postage pre-paid, upon Applicant’s counsel of record:

James A. Italia  
Italia IP  
3500 West Olive Avenue, Suite 300  
Burbank, California 91505-4647

in accordance with Trademark Rule §§ 2.201 and 2.119 on this \_\_\_ day of February, 2010.

/ Luis M. Lozada /  
Luis M. Lozada

NGEDOCs: 1687108.1